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In the

Supreme Court of the United States

OCTOBER TERM, 1964

No. 687

INDUSTRIAL SHOE MACHINERY CORP.,
PETITIONER,

v.

UNITED SHOE MACHINERY CORPORATION,
RESPONDENT.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

Introduction

This is an ordinary suit for patent infringement in which the Court of Appeals for the First Circuit correctly held valid plaintiff-respondent's patent No. 2,926,367 relating to a toe lasting machine, employed for lasting the uppers of shoes. The District Court for the District of Massachusetts had held the patent invalid "for want of invention" in an opinion reported at 223 F. Supp. 826 wherein respondent's two other patents in suit (not here involved) also were held invalid. The Court of Appeals reversed the District Court only as to patent No. 2,926,367, its opinion, as amended by

Order of Court of August 20, 1964, being reported at 335 F.2d 577.*

The Court of Appeals holding that respondent's said patent is valid provides no basis for any "special or important" reason for review on writ of certiorari,—and the Petition does not assert a single reason of the character which will be considered as indicated in this Court's Rule 19.1.(b) setting forth general considerations governing review on certiorari. There is no reason why this Court should grant certiorari. Furthermore, the Court of Appeals' decision that this patent is valid is entirely sound.

Statement

The relevant and determinative facts of the case, which are essentially undisputed, being based largely on documentary evidence including prior art patents and undisputed oral testimony, are correctly set forth in the Court of Appeals opinion. The so-called "findings" of the District Court mentioned in plaintiff's petition are either conclusory or largely argumentative, except as to the machine structure and operation of the various patents therein specified which findings the Court of Appeals accepted. The "finding of invalidity" or "finding of no invention" (Petition, p. 7), —generally corresponding to "6." under "D. Patentability

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*The July 15, 1964 opinion of the Court of Appeals in unamended form is printed in Appendix A of the Petition (pages 9-16) with the amending Order of Court of August 20, 1964 printed in Appendix C of the Petition (page 18).

The Order of August 20, 1964 may be applied to the opinion as printed and page numbered in the Petition, by reading "Page 3" of said Order as page 11 of the Petition, and reading "Page 6" of said Order as page 14 of the Petition. For convenience, our references to the Court of Appeals' opinion will be simply to the opinion as printed and paged in Appendix A of the Petition (pages 9-16).

The Record herein, made up of two volumes with continuous paging as printed for the Court of Appeals, entitled "Record Appendix to Brief for Appellant", will be referred to in this brief as "R.___").

of Patent No. 2,926,367" (R. 189-191)*—was most certainly a conclusion of law.

Patent No. 2,926,367 (Pl. Ex. 20; R. 31, 227) is directed to novel mechanical combinations by which the operator of a manually controlled toe lasting machine is able to apply power to assist him in the laborious overwiping and bedding down steps readily and to terminate that power, at any stage, according to his judgment as the lasting progresses. Thus, either manual or power operation may be invoked or discontinued by the operator at any time during the lasting operation at his entire discretion,—a highly important feature. The Court of Appeals in its decision adequately and accurately discussed toe lasting and the patent in suit, distinguishing the two prior art patents referred to by the District Court, as appears from the decision to which we respectfully refer this Court (Petition, pp. 10-14).

Though Petitioner (p. 6) complains that "the opinion of the Court of Appeals contains serious misstatements of fact prejudicial to Industrial and wholly unsupported by the record", it simply makes such unwarranted charge without specified record support and, indeed, refers only to the Court of Appeals opinion (footnote, Petition, pp. 6-7). Even in so doing, the Petition misinterprets the first quoted statement of the footnote by interpolating "[United's patent]" whereas the Court obviously was referring to the "lasting operations" of United's "combination *machine*" (of the immediately preceding sentence of its opinion, Petition, p. 13), as showing a "substantial advance" in practise, not patentable invention, such sentence reading:

> "United was the first to devise a combination machine whereby the three lasting operations could be sepa-

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*"6. All the claims of Patent No. 2,926,367 are invalid for want of invention."

> rately performed with full discretionary, and a locking, power assist that permitted selective repetition 'sequentially as well as alternatively.' "

This is the crux of the case,—fully supported by fact findings 7-18 of the District Court (R. 186-189).

The Reasons Asserted in the Petition for Granting a Writ are Not Presented by this Case

The Petition (p. 2) lists three "Questions Presented for Review", none of which is of the stature or character here required for review. We quote and then comment on each question.

> "1. Is a Judge of a United States District Court competent to find a patent invalid for want of invention [?]."

No such question as "1" is here presented. Indeed, in saying (Petition, p. 12) that "we question, in the absence of affirmative evidence enabling the court to put itself in the position of such persons, whether its own judicial competence may extend beyond a relatively narrow area", the Court of Appeals was doing no more than stating the classical rule of law as to the limitations on the proper scope of judicial notice. The propriety of what it said was only underlined by the next following sentence of its opinion, with respect in effect to a proper exercise of such notice.

> "2. If a District Court, after a full trial, makes detailed findings that a patent is invalid, can a Court of Appeals reverse those findings without showing them to be clearly erroneous?"

As to "2",—Petitioner's assertion (Petition, p. 7) that "[r]eview is needed to bring Rule 52a back to the First Circuit" is of course without merit. Only recently that Court of Appeals ruled, in no uncertain terms (*Evans* v. *United States*, 319 F.2d 751, 753 [1963]):

> "With the case in this posture the findings of the trial judge come to us with 'the buckler and shield', McGowan v. United States, 296 F.2d 252, 254 (5th Cir., 1961), of the Federal Rules of Civil Procedure which provide that findings of fact by a trial court 'shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' F.R.Civ.P. 52(a), 28 U.S.C.; D'Orsay Equipment Co. v. United States Rubber Company, 302 F.2d 777, 778 (1st Cir., 1962); A. Belanger & Sons, Inc. v. United States, 275 F.2d 372, 375 (1st Cir., 1960). It is settled that an appellate court has no power to disturb a finding of fact of a trial court where it is based on some substantial though conflicting evidence. Jue v. Bass, 299 F.2d 374, 377 (9th Cir., 1962). An appellate court, in determining the presence or absence of substantial evidence, is not required to reweigh the evidence adduced in the trial court but need only scrutinize the record to ascertain if it affords some reasonable basis for the result achieved."

Nor has it overlooked the fact that patent actions too are governed by the Federal Rules of Civil Procedure. Less than a year ago the same panel that decided *Evans* and the present action said (*Wilson Research Corp.* v. *Piolite Plastics Corp.*, 32. F.2d 139, 140, footnote [1963]), speaking through Judge Aldrich, who also wrote the opinion now attacked by petitioner:

> "[V]alidity was a clear decision of fact which we would not disturb."

And in *Hap Corporation* v. *Heyman Manufacturing Company*, 311 F.2d 839, 843 (1962), cert. den'd 373 U.S. 903:

> "Suffice it to say [the record as to invalidity] was a factual situation, and that we are not prepared to say the court was plainly wrong."

That invention turns in particular cases on questions of fact (which tend thus to elicit language like that just quoted) is in no way inconsistent with this Court's holding, in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, 148, 153-4 (1950), that the ultimate standard to be applied is a question of law (which circumstance, in cases in which the facts are so clear that the real, practical problem for the court is the legal standard, tends to elicit the remark that "validity is a question of law".) As it was recently put by Circuit Judge Brown for the court, in *Hughes Tool Co.* v. *Varel Manufacturing Co.*, 336 F.2d 61 (5 Cir. 1964):

> "Validity of patent, while often a pure legal question, is frequently one of fact for resolution by trier. . . ."

The nature of the issue was discussed at great length and in careful detail in an *en banc* decision in *Armour & Co.* v. *Wilson & Co.*, 274 F.2d 143, 151-7 (7 Cir. 1960), in which the court properly recognized that this Court had emphasized the factual aspect of the mixed question of fact and law in *Graver Mfg. Co.* v. *Linde Co.*, 336 U.S. 271 (1949; Petition, p. 7), and the legal standard aspect in *A. & P.*, supra. In the case at bar, there was no relevant conflicting

factual material, so that, as in *A. & P.*, the real question was one of law.

> "3. If a manufacturer has been adjudicated a monopoly, can a District Court consider the existence of such adjudication in evaluating the contention of the manufacturer that extensive sales show patentable invention?"

No such question as "3" is here presented. Moreover, this question, at most, is academic. The Court of Appeals by no means held that the District Court should have considered the "extensive sales" as indicating invention and, instead, assumed arguendo that the District Court properly did not. (See last full paragraph, Petition, p. 13 and footnote 3 thereto).

Conclusion

The Petition does not set forth a sound or adequate basis for review on writ of certiorari and, accordingly, should be denied.

Respectfully submitted,

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